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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANTS: Salemi et al.

EXAMINER: Cordray

ATTY. DOCKET NO.: MEG-P-03-001

GROUP ART UNIT: 1731

FILING DATE: September 10, 2003

SERIAL NO.: 10/659,089

INVENTION: "AN INDENTED ANTIMICROBIAL PAPER AND A PROCESS FOR
MAKING AND USING THE SAME"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

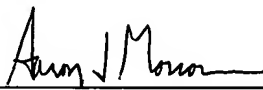
APPELLANTS' REPLY BRIEF TRANSMITTAL

SIR/MADAM:

Appellants submit herewith Appellant's Reply Brief in response to the Examiner's Answer dated June 4, 2008.

Appellants submit that no fee is required for submission of this Reply Brief. However, the Patent Office is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Acct. No. 50-0595. A duplicate of this sheet is enclosed for this purpose.

Respectfully submitted,

 (Reg. No. 55,819)
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APPELLANTS' REPLY BRIEF

SIR/MADAM:

This Reply Brief is submitted in response to the Examiner's Answer dated June 4, 2008. In the Examiner's Answer, the Examiner raised new points of argument.

I. STATUS OF CLAIMS

Claims 30-51 and 53-55 are pending in this patent application. In a Final Rejection dated January 1, 2007, the Examiner indicated that Claims 15-19 would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims. To this end, Appellants cancelled Claims 1-29, added new Claims 30-34 incorporating dependent Claims 15-19 into independent Claim 12 and paid the fees associated with addition of the new Claims. In an Office Action dated May 30, 2007, the Examiner withdrew the allowability of the subject matter of Claims 30-34. In response, Appellants amended Claims 30-34 and added Claims 35-51 and 53-55 directed to the subject matter of cancelled Claims 1-29. Claims 35-51 and 53-55 were finally rejected by the Examiner in a Final Rejection dated October 26, 2007 and are hereby on appeal. A copy of the claims was appended to the Appeal Brief in the Claims Appendix.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 30, 31, 34, 36, 38, 39, 43-45, 47, 48 and 55 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

2. Claims 30, 33, 34, 37, 41, 44, 45, 47, 48, 51 and 53-55 are rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

3. Claims 30-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Santelli* (U.S. Patent App. Publication No. 2004/0071902) in view of *Trogolo et al.* (U.S. Patent No. 6,248,342) and *Nakamura* (U.S. Patent No. 6,179,141) and further in view of *Otten et al.* (U.S. Patent No. 6,274,232).

4. Claims 49-51 and 53-55 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Santelli* in view of *Trogolo et al.* and *Nakamura* and further in view of *Otten et al.* and even further in view of *Weder* (U.S. Patent No. 5,921,062).

III. ARGUMENT

THE CITED REFERENCES AND REJECTIONS OF CLAIMS 30-48 UNDER 35 U.S.C. §103(a)

In the Examiner's Answer, the Examiner alleges that merely the order of assembly of the laminates of *Santelli* differs from the claimed process. The Examiner proceeds to state that "no evidence has been provided to demonstrate that the sequence of laminating the layers is critical to the instant invention and performing the laminating steps in any sequence would have been obvious to one of ordinary skill in the art in the absence of new or unexpected results" (Examiner's Answer, pages 9-10). Further, the Examiner alleges that *Santelli* discloses examples and preferred embodiments and does not teach away from the claimed inventions. Moreover, the Examiner continues to allege that combination of the cited references would have been obvious to one skilled in the art.

However, the claimed inventions have steps and structural features not disclosed by *Santelli*. No evidence need be provided to demonstrate that the sequence of laminating the layers is critical to the instant invention, since *Santelli* lacks the steps required in the claimed processes. As noted in the Appeal Brief, *Santelli* merely teaches a biocide-containing laminate fabricated from a paper-plastic laminate sheeting that is adhesively laminated. *Santelli* teaches only a paper-plastic laminate (page 3, paragraph 28), a plastic-paper-plastic laminate (page 3, paragraph

34), a plastic-plastic laminate (page 4, paragraph 35) and paper-plastic-plastic, paper-plastic-plastic-paper, paper-plastic-paper-plastic and paper-plastic-paper-plastic-paper laminates (page 5, paragraph 54). These laminates are in contrast to a first polyurethane antimicrobial layer attached to a water resistant layer attached to a sheet attached to a second polyurethane antimicrobial layer, which provides the plastic-paper-plastic-plastic laminate of Claims 30 and 31, for example.

The Examiner cites *In re Fulton* for the proposition that "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives" (Examiner's Answer, page 15). However, as discussed in the Appeal Brief and previously in this Reply Brief, the claimed inventions are not alternatives taught by *Santelli*. *Santelli* does not teach or suggest the claimed inventions. Therefore, *In re Fulton* is not applicable to the present appeal.

Moreover, no teaching or suggestion exists to combine the teachings of the cited references. As discussed above, *Santelli* teaches away from the claimed invention. Further, *Trogolo et al.* teach a laminate to be bonded to appropriate substrates to form antimicrobial table tops, cabinets, wall paneling, and counter tops. Application of such a laminate to a paper would not have been obvious to one having ordinary skill in art. Still further, *Nakamura* teaches a seal member, such as a crown cap, fitted to a

mouth portion of a plastic bottle. Application of features of a seal member to an antimicrobial paper would not have been obvious to one having ordinary skill in art.

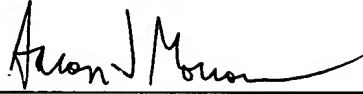
In addition, the channels of the claimed inventions increase contact between the antimicrobial agent and the food by increasing the surface area of the sheet in contact with the food. Further, the channels of the claimed inventions create air pockets of oxygen and moisture that increase the antimicrobial activity of the antimicrobial agent. Still further, the channels of the claimed inventions allow cool air to flow around the food, which decreases bacteria counts. These unexpected results further demonstrate that combination of the cited references would not have been obvious to one having ordinary skill in art.

No evidence need be provided to demonstrate that the sequence of laminating the layers is critical to the instant invention, no teaching or suggestion exists to combine the teachings of the cited references, and the references lack the novel features and steps positively recited in independent Claims 30-35, 44 and 51. Accordingly, Appellants assert that the rejection of Claims 30-48, 49-51 and 53-55 under 35 U.S.C. §103(a) is improper and should be reversed.

In view of the foregoing remarks, Appellant respectfully submits that all of the claims in the application are in allowable form and requests the Board to reverse the rejections of the

Examiner.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **REPLY BRIEF** and a **REPLY BRIEF TRANSMITTAL** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 4, 2008.



Aaron J. Morrow (Reg. No. 55,819)